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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,198	11/30/2000	Pierre L. Triozzi	CIR 2-005	2840

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EXAMINER	
WINKLER, ULRIKE	
ART UNIT	PAPER NUMBER
1648	

DATE MAILED: 06/18/2002 7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/727,198	TRIOZZI ET AL.	
	Examiner	Art Unit	
	Ulrike Winkler, Ph.D.	1648	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 March 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-66* is/are pending in the application.

4a) Of the above claim(s) *6,7 and 9-66* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5 and 8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Applicant's election with traverse of Group I (claims 1-5 and 8) with a further election to cancer in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the restriction appears "illogical". This is not found persuasive because applicant's have chosen to describe their factor (a product) as being **greater than or equal to 50kDa.** If the factor interpreted to be limited to being greater than 50kDa then the dependent claims are correctly dependent as applicant suggest in the traversal. However, if this factor is **equal to 50 kDa** (which falls within the scope of the claim as drafted) then the factor cannot at the same time be 70-80kDa. If the factor is equal to 50 kDa it is obvious that two different factors are contemplated between groups I and II making them patentably distinct; one factor which is 70-80kDa and the other which is 50kDa. The specification provides no insight with regards to the factor (page 29, lines 13). It is not clear that Factor C, the 70-80kDa fraction, as described is the product of single protein having a molecular weight of 70-80kDa or if it is a multimeric structure of a single protein with lower molecular weight or if it is a multimeric structure comprising multiple different proteins forming an associated mass of 70-80 kDa as determined by filtration and size exclusion chromatography. The factor could conceivably be a mixture of a 50kDa protein and a 25kDa protein, or a trimer of a 25 kDa protein. The claims are vague in what is intended by the factor. Furthermore, later claims specifically only refer to the factor as being greater than 50 kDa.

Upon review of the Restriction/Election requirement, claims 62 and 63 should be in Group 13 and not Group 2 as listed in Paper No.5, and claim 42 should be only in Group 10.

The requirement is still deemed proper and is therefore made FINAL.

Applicant is advised that a rejoinder of claims is possible at a later date if the product is eventually found patentable. Guidance on treatment of product and process claims in light of *In re Ochiai, In re Brouwer* and 35 U.S.C. §103(b) is set forth in the Commissioner's Notice of February 28, 1996 published on March 26, 1996 at 1184 O.G. 86.

> To facilitate examination under § 103, where product and process claims are presented in the same application, applicant may be called upon under 35 U.S.C. § 121 to elect claims to either the product or process. The claims to the non-elected invention will be withdrawn from further consideration. However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim. Withdrawn process claims not commensurate in scope with an allowed product claim will not be rejoined. In the event of rejoinder, the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104 - 1.106. If the application containing the rejoined claims is not in condition for allowance, the subsequent Office action may be made final, or, if the application was already under final rejection, the next Office action may be an advisory action.

Amending the claims to specifically claim a factor which is only greater than 50kDa but not simultaneously equal to 50kDa would result in the rejoinder of Groups 2 and 13 with Group 1.

Sequence listing

Applicant's CRF and paper sequence listing have been entered.

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be

incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

The drawings have been approved by the Draftsperson.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 and 8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11, 12, 14, 17 and 18 of U.S. Patent No. 6,093,381. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are directed at treating a patient afflicted with a disease -cancer- comprising a greater than or equal to 50kDa fraction of a supernatant from mitogenically stimulated lymph node lymphocytes. The factor is obtained from cells stimulated with IL-2 and anti-CD-3 Ab. The patented claims are drawn to a whole supernatant fraction from lymph node cells stimulated with IL-2 and anti-CD-3 Ab. The patented claims are drawn

to improving the treatment of cancer patients utilizing this supernatant which inherently contains the greater than or equal to 50kDa fraction. The limitation of "treating patients" is broad and includes combination therapies as found in claims 11, 12, 14, 17 and 18 of U.S. Patent No. 6,093,381.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-5 and 8 are rejected under 35 U.S.C. 102(a) or 35 U.S.C. 102(e) as being anticipated by Triozzi et al. (U.S. Pat. No. 6,093,381).

The instant invention is drawn to a factor (a composition) for treating a patient afflicted with a disease (cancer) derived from the supernatant of activated lymphocytes that have been stimulated with a mitogen (Il-2 and anti-CD3 Ab).

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

MPEP 211.03: The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.).

Triozzi et al. disclose a supernatant derived from cancer patient lymph node lymphocytes that are stimulated with IL-2 and anti-CD3 Ab. The supernatant contains all molecular weight fractions including those that are greater than or equal to 50kDa. The reference discloses using the supernatant as a treatment. Therefore, the instant invention is anticipated by Triozzi et al.

Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Chang et al. (U.S. Pat. No. 4,596,774).

The instant invention is drawn to a factor (a composition) for treating a patient afflicted with a disease derived from the supernatant of activated lymphocytes that have been stimulated with a mitogen. See interpretation of "intended use" and the term "comprising" above.

Chang et al. disclose the methods of preparing cell-free products (supernatant) from stimulated peripheral blood lymphocytes. The supernatant contains all molecular weight fractions including those that are greater than or equal to 50kDa (see figure 5). Therefore, the instant invention is anticipated by Chang et al.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Triozzi et al. (AIDS Reasearch and Human Retrovirus, 1998).

The instant invention is drawn to a factor (a composition) for treating a patient afflicted with a disease derived from the supernatant of activated lymphocytes that have been stimulated with a mitogen (Il-2 and anti-CD3 Ab). See interpretation of "intended use" and the term "comprising" above.

Triozzi et al. disclose mitogen stimulated lymph node lymphocytes for preparing cell-free products (supernatants). The supernatant contains all molecular weight fractions including those that are greater than or equal to 50kDa (see page 645- HIV-1 suppression). Therefore, the instant invention is anticipated by Triozzi et al.

Claims 1 and 5 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanaka et al. (EMBO Journal, 1995).

The instant invention is drawn to a factor (a composition) for treating a patient afflicted with a disease derived from the supernatant of activated lymphocytes that have been stimulated with a mitogen. See interpretation of "intended use" and the term "comprising" above.

Tanaka et al. disclose mitogen stimulated peripheral blood T lymphocytes for preparing a cell-free product: sFasL. The reference discloses that sFasL forms trimers and therefore achieves a size greater than the monomeric 40 kDa membrane form (greater than 50Kda). FasL association with Fas results in the activation of apoptosis leading to cell death and any cell that caries Fas is susceptible to this death pathway. Therefore, the instant invention is anticipated by Tanaka et al.

Allowable Subject Matter

Specifically claiming the compounds that constitute the "active" factor, which according to specification may comprise more than one molecule may be allowable. The "active" factor must be claimed by the individual constituents the fraction, this can be achieved by disclosing the molecular weight as determined by SDS-Page, or by their N-terminal sequences (SEQ ID NO:5) in conjunction with the specific cell origin.

Conclusion

No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ulrike Winkler, Ph.D. whose telephone number is 703-308-8294. The examiner can normally be reached M-F, 8:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached at 703-308-4027.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for informal communications use 703-308-4426.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Ulrike Winkler, Ph.D.

JEFFREY STUCKER
PRIMARY EXAMINER